

REMARKS

Claims 1-12 are pending in this application. Claims 9 and 10 have been amended in order to correct a minor grammatical error. It is submitted that these minor amendments introduce not new issues, and in fact reduce the number of issues concerning this application (by eliminating a potential issue under 35 U.S.C. § 112), such that these amendments should be entered of record under 37 C.F.R. § 1.116.

Issues under 35 U.S.C. § 103(a)

Claims 1-12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoshi '958 (Japanese Patent Application No. 10-248958) in view of Yamagishi '503 (USP 5,601,503). This rejection is reversed for the following reasons.

Summary of Comments in Final Office Action

The Final Office Action dated April 14, 2002 states that the Patent Examiner maintains her position that Satoshi '958 may be combined with Yamagishi '503 in order to obtain the golf ball of the present invention having all of the features recited in the present claims. However, the Final Office Action fails to include any sufficient basis for a motivation to one skilled in the art to have combined Satoshi '958 with Yamagishi '503, other than the implied general basis that both of these documents relate to golf

balls. For the reasons stated below, significant inconsistent features between Satoshi '958 and Yamagishi '503 prevent these documents from being combined together, other than relying on improper "hindsight reconstruction" which is prohibited as stated in the MPEP. After reviewing the distinctions between the present invention and each of Satoshi '958 and Yamagishi '503 separately, the significant inconsistencies between these documents are discussed.

Distinctions between Present Invention and Satoshi '958

Satoshi '958 is mentioned at page 1 of the present specification. Satoshi '958 includes a "computer translation" into English which describes various materials for the core and cover of various golf balls. Satoshi '958 discloses in [0016]-[0017] a core which exhibits a compression in the range of 2.5-4.5 mm by applying an initial load of 10 kg up to 130 kg. The computer translation of Satoshi '958 does not include specific information regarding the dimple diameter or contour lengths of the dimples.

Satoshi '958 fails to disclose or suggest the golf ball of the present invention which includes the feature of having at least 50% of the dimples with a contour length of greater than or equal to 11.6 mm. Therefore, significant patentable distinctions exist between the present invention and Satoshi '958.

Distinctions between Present Invention and Yamagishi '503

Yamagishi '503 discloses a golf ball having a diameter of 43-47 mm, "preferably 43.3 to 46.3 mm," (Column 2, lines 64-65). Yamagishi '503 also discloses a golf ball which includes a core that may be formed from a cross linked rubber composition as noted at column 4, lines 18-50, and a cover that may be formed from an ionmer resin as noted at column 5, lines 14-17. Yamagishi '503 further discloses that the core is recommended to undergo a distortion of 2.2-5.0 mm, especially 2.7-4.5 mm, under an applied load of 100 kg. Further, Yamagishi '503 discloses that the cover has a Shore D scale of at least 60, preferably 62-70 (col. 5, lines 19-21). A comparison of the ball diameter and dimple contour length features among the various examples and comparative examples of Yamagishi '503 is provided in the attached table of Exhibit A. Examples 1-4 of Yamagishi '503 are described at columns 5-7 and include various dimple arrangements, the dimensions being summarized in Table 2 at column 7, lines 1-13.

Yamagishi '503 fails to disclose or suggest a golf ball, as in the present invention, which has a diameter with an upper limit of 42.85 mm. As noted above, all of the examples described by Yamagishi '503, i.e. Examples 1-4, have diameter in the range of 43.50-46.10 mm which are all greater than the diameter of the golf ball of the present invention. It is also noted that the smaller diameters of Comparative Examples 1 and 2 of 42.70 mm fail to

include the appropriate percentage of dimples having a contour length of greater than or equal to 11.6 mm, such that these Comparative Examples are also inconsistent with the present invention. Consequently, it is submitted that significant patentable distinctions exist between the present invention and Yamagishi '503, such that the present claims patentably define over this document.

Reasons that Satoshi '958 Cannot Be Combined with Yamagishi '503

Yamagishi '503 is inconsistent with Satoshi '958, because Yamagishi '503 requires the golf ball diameter of a minimum of 43 mm, while Satoshi '958 allows for a smaller diameter of 42.7 mm as described at paragraph [0028]. Yamagishi '503 requires the outer diameter of at least 43 mm in order to achieve the described improved trajectory. Note that Yamagishi '503 discloses at column 2, line 64 to column 3, line 2, that:

The golf ball has an outer diameter of **43 to 47 mm, preferably 43.3 to 46.3 mm**. Outside the range, smaller diameter balls are difficult to hit high, not different from conventional golf balls, and detrimental to take the proper posture or stance upon address, failing to attain the objects of the invention. [emphasis added]

It is further described at column 2, lines 15-25 of Yamagishi '503 that,

The golf ball has the problem that reducing the ball weight will lead to a higher trajectory, but a shorter flying distance. We have found that a golf ball having a weight of 40 to 45 grams, an outer diameter of 43 to 47 mm, and dimples occupying at least 60% of the ball surface and satisfying $0.35 \leq V_0 \leq 0.60$ wherein V_0 is as defined above has improved flying performance in that it follows an adequately high trajectory to ensure an increased flying distance without following a low or sharply climbing trajectory when ordinary golfers with a head speed of about 40 m/sec. shoot it with a driver. [emphasis added]

In addition to the above, it is noted that the United States Golf Association has set a lower golf ball diameter limit of 42.67 mm, but has set no upper limit. Thus, so-called standard size golf balls have a diameter of in the range of about 42.67-42.85 mm, whereas in contrast, so-called "big balls" have a diameter of about 43-47 mm. Consequently, it is very clear that Yamagishi '503 is directed to a so-called "big ball" from the above quoted portions.

Further, Yamagishi '503 clearly describes that a diameter less than 43 mm is disadvantageous and should not be used. This is further evidenced by the comparative test results shown in Table 1 at columns 5-6 wherein comparative Example Nos. 1 and 2 each have diameters of 42.70 mm and each exhibit inferior carry and trajectory angle properties when compared to Example Nos. 1-4 which are balls made in accordance with the description of Yamagishi '503. In contrast, Satoshi '958 fails to address or recognize any

issues associated with requiring a minimum ball diameter of 43 mm, and in fact, simply describes a completely inconsistent ball diameter of 42.7 mm. The Final Office Action simply fails to describe any reason that the golf balls described by Yamagishi '503 should be modified to have a smaller diameter even though Yamagishi '503 states that a smaller diameter is "detrimental" and teaches away from attempting to make this modification. The Final Office Action fails to indicate any portion of Satoshi '958 which addresses or recognizes ball diameter properties in an attempt to achieve the advantages described in Yamagishi '503, or in an attempt to change any trajectory or carry golf ball properties at all. Additionally, Satoshi '958 fails to address or recognize any significance associated with the volume of dimple space which is described as being critical in order to achieve the trajectory and carry properties disclosed in Yamagishi '503, and which must be varied within specific parameters in order to achieve these results.

In view of the above, Satoshi '958 cannot be combined with Yamagishi '503. Note the fact that the invention claimed in the present application may be within the capabilities of one of ordinary skill in the art fails to be sufficient by itself for establishing prima facie obviousness. In re Kotzab, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); and MPEP § 2143.01, page 2100-126. Further, the proposed modification of Yamagishi '503 to reduce the

golf ball diameter described therein despite the description that detrimental properties will result is a proposed modification that renders the description in this prior art document unsatisfactory for its intended purpose. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984); and MPEP § 2143.02, page 2100-127. Consequently, because Satoshi '958 cannot be combined with Yamagishi '503, all the claim features of claim 1 have not been disclosed or suggested by the cited prior art document Yamagishi '503. Specifically, the claimed ball diameter of less than 43 mm fails to be disclosed or suggested by Yamagishi '503. Therefore, prima facie obviousness has not been established. In re Sang Su Lee, 61 USPQ2d 1430 (Fed. Cir. 2002); and MPEP 2143.03, page 2100-128.

It is submitted for the reasons stated above that the present claims define patentable subject matter such that this application should be placed into condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Andrew D. Meikle, #32,868

ADM/csm
3673-0128P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims have been amended as follows:

9. The golf ball according to claim 1 wherein the total number of dimples is in the range of from 200 to 600.

10. The golf ball according to claim 1 wherein the total number of dimples is in the range of from 360 to 450.